IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

JAMES D. MARKS and PETER AMERSDORFER

Application No.: 09/144,886

Filed: August 31, 1998

For: THERAPEUTIC MONOCLONAL ANTIBODIES THAT NEUTRALIZE BOTULINUM NEUROTOXINS.

Examiner: L. Lee

Art Unit: 1645

#10 1/11/00 T. Gray

Assistant Commissioner of Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231 on December ~~21~~ 28, 1999.

Name: SANDY ELLSWORTH

Sandy Ellsworth 12/28/99

Signature Date

RESPONSE

Sir:

In response to the Office Action dated October 5, 1999, Applicants respectfully request reconsideration of the above-identified application in view of the following remarks. An Information Disclosure Statement (form 1449) and a petition to extend the period of response for two months are enclosed.

REMARKS

In the Office Action dated October 5, 1999, the Examiner required restriction to one of the following groups under 35 U.S.C. §121:

Group I: Claims 1-43, drawn to botulinum neurotoxin-neutralizing antibodies;

Group II: Claims 44-63, drawn to methods of neutralizing a botulinum neurotoxin type A;

Group III: Claims 64-69, drawn to botulinum neurotoxin fragment comprising an epitope bound by a neutralizing antibody; and

Group IV: Claims 70-77, drawn to methods of making an anti-botulinum neurotoxin type A antibody.

In response to this restriction requirement, **Applicants provisionally elect Group I, claims 1-43, with traverse.**

Applicants submit that restriction between Groups I, II, III, and IV is unnecessary. According to MPEP §803, the Examiner should examine all claims in an application, even though they are directed to distinct inventions, unless to do so would create a serious burden. In the instant case, Group I claims are drawn to antibodies neutralizing a botulinum neurotoxin type A, while Group II claims are drawn to method of neutralizing botulinum neurotoxin type A using the antibodies of Group I. Group IV is drawn to methods of making such antibodies. A search drawn to botulinum neurotoxin type A neutralizing antibodies would be expected to identify prior art, if it exists, relevant to any of Group I, Group II, or Group IV. The search for Groups I, II, and IV is essentially co-extensive. Thus a search for prior art relevant to Group I, II, and IV together entails no greater burden than a search for art relevant to Group I alone. Accordingly there is no "serious burden" and the restriction between Groups I, II, and IV should be withdrawn.

Similarly the claims of Group III are drawn to epitopes recognized by the botulinum neurotoxin-neutralizing antibodies. Again a search relevant to the antibodies is expected to find prior art, if it exists, relevant to the epitope those antibodies bind. A search for art relevant to Group III thus entails no greater effort than a search for art relevant to Groups I, II, or IV. There is no serious burden and accordingly, Group III should be reunited with Groups I, III, and IV.

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 248-5500.

Dated: December 21, 1999.

Respectfully submitted,

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Atty. Docket: 2500.136US2

encl: 1) Petition for 3 month extension of time.
2) Form 1449 and associated references.

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